

REMARKS

The Office Action mailed December 15, 2005 required restriction from among:

- Group I: Claims 1-17, 20, 24-29, drawn to nucleic acids, kits, vectors, and host cells, classified in class 435, subclass 69.1, 91.1, 320.1 and 252.3, for example;
- Group II: Claims 18-19, drawn to methods of amplifying nucleic acid, classified in class 435, subclass 91.2;
- Group III: Claims 21-23, drawn to methods of detecting nucleic acids, classified in class 435, subclass 6;
- Group IV: Claims 30-36, drawn to polypeptides, classified in class 530, subclass 350.
- Group V: Claim 37, drawn to a method to screen ligands in a cell-based assay by measuring electrical parameters, classified in class 435, subclass 7.21; and
- Group VI: Claim 38, drawn to a method to screen ligands in a cell-free assay by measuring binding, classified in class 435, subclass 7.1.

Furthermore, provided that any of Groups I-III were elected, Applicants were required to elect a single nucleic acid sequence for examination.

Applicants hereby elect, with traverse, the claims of Group I and the nucleic acid sequence set forth in SEQ ID NO: 2.

The MPEP lists two criteria for a proper restriction requirement. First, the invention must be independent or distinct. MPEP § 803. Second, searching the additional invention must constitute an undue burden on the examiner if restriction is not required. *Id.* The MPEP directs the examiner to search and examine an entire application “ [i]f the search and examination of an entire application can be made without serious burden, ... even though it includes claims to distinct or independent inventions.” *Id.*

Thus, for a restriction requirement to be proper, it must satisfy both of the above elements. The Office Action both alleges that the claims of Groups I through VI are distinct, and that searching and examining both groups would cause serious burden on the Examiner. Applicants respectfully traverse both allegations.

Applicants first direct the Examiner's attention to the classifications provided for each Group in the Office Action. The claims of Groups I, II, III, V and VI are all classified in class 435, demonstrating that a search and examination of these claims would likely be interrelated and overlapping, and would not require searching outside of a single class. Furthermore, the claims of Groups I, II, III are all identified in the Office Action as claiming or relating to nucleic acids, thereby further showing the interrelatedness between the claims. Additionally, Group III

includes only three claims, and each of Groups V and VI contain a single claim, such that the search and examination of an additional small number of claims is unlikely to result in a serious burden, especially as Applicants have been required to elect a single nucleic acid sequence for examination. Accordingly, reconsideration and withdrawal of the restriction requirement is respectfully requested as the search and examination of all of the claims of Groups I-VI, or at the very least, of all of the claims of Groups I, II, and III.

The Office Action additionally required the election of a single nucleic acid sequence for examination if any of the claims of Groups I-III were elected, although the Office Action refrained from characterizing the additional restriction as an election of species requirement. It is respectfully requested that Applicants be allowed to select a small group of nucleotide sequences for examination. Applicants maintain that the search and examination of a small number of sequences, for example, SEQ ID Nos: 1-4, would not constitute an undue burden on the Examiner and would not prevent the prejudice to Applicants that results from such restrictions. Consequently, reconsideration and withdrawal of the election of species requirement are requested.

In summary, enforcing the present restriction requirements would result in inefficiencies and unnecessary expenditures by both the Applicants and the PTO, as well as extreme prejudice to Applicants (particularly in view of GATT, whereby a shortened patent term may result in any divisional applications filed). Restriction has not been shown to be proper, especially since the requisite showing of serious burden has not been made. Indeed, the search and examination of each Group would be likely to be co-extensive and, in any event, would involve such interrelated art that the search and examination of the entire application can be made without undue burden on the Examiner. All of the preceding, therefore, mitigate against restriction.

CONCLUSION

Reconsideration and withdrawal of the restriction requirement and election of species and an early and favorable examination on the merits is respectfully requested in view of the remarks herein.

Respectfully submitted,

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